

No. 4582.

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IN THE  
United States  
Circuit Court of Appeals,  
FOR THE NINTH CIRCUIT. 2

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David G. Lorraine, and The Lorraine  
Corporation, a corporation,

*Appellant.*

*vs.*

Francis M. Townsend, Milon J. Trum-  
ble and Alfred J. Gutzler, doing  
business under the firm name of  
Trumble Gas Trap Company,

*Appellees.*

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**APPELLANT'S OPENING BRIEF.**

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*Solicitors and of Counsel for Appellant-Plaintiff.*

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## APPELLANT'S OPENING BRIEF.

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### Copies of Exhibits.

There should be before the court when reading this brief besides the transcript of record in two volumes and Book of Exhibits, a volume of Bound Copies of Patents. Numerous unwieldy paper exhibits such as rolled blue prints, magazine covers, advertisements and drawings were in evidence; and in preparing the record it was believed that reproduction in a book of exhibits, even (in the case of many of the blue prints) on a

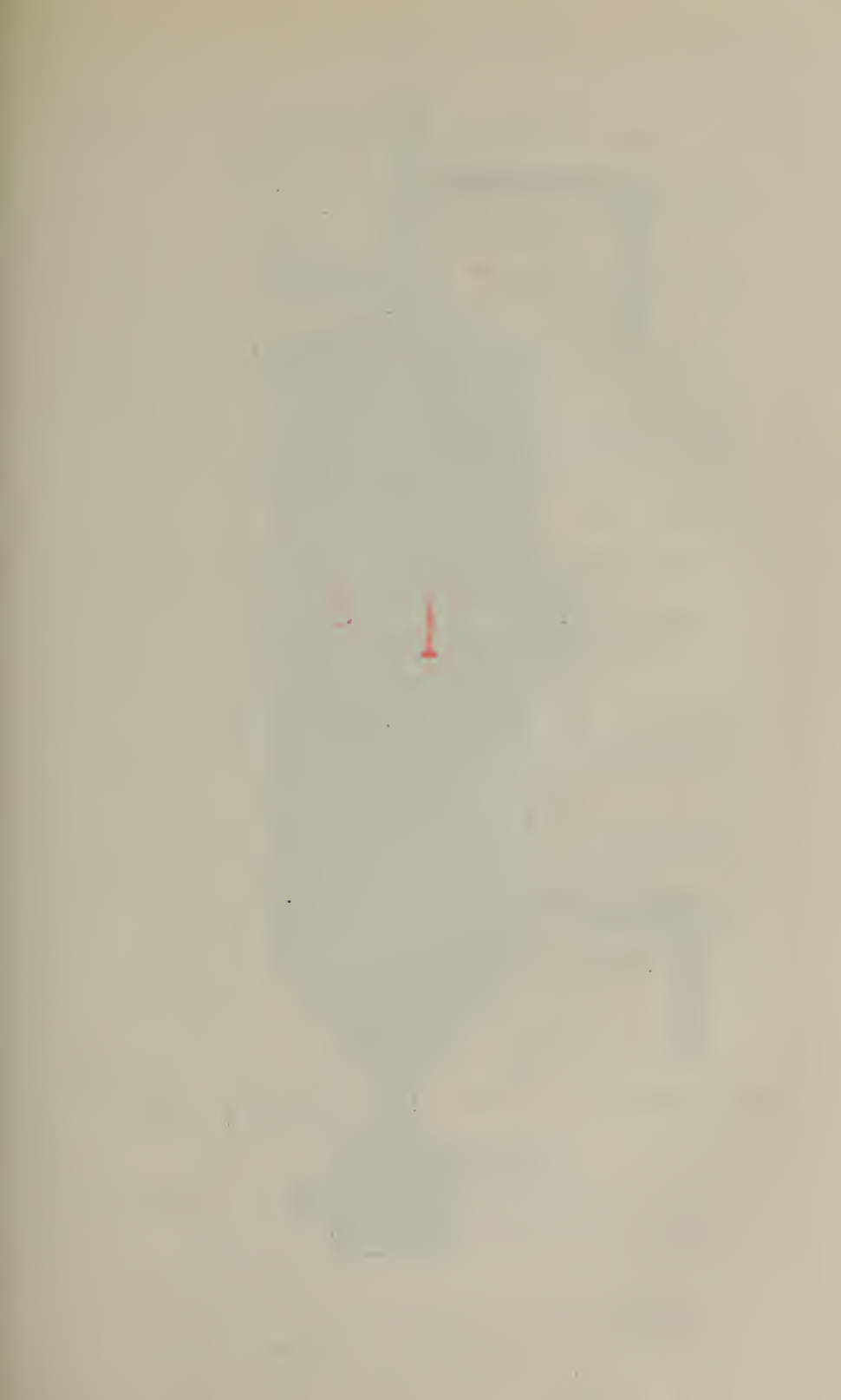
greatly reduced scale would be preferable to endeavoring to handle the originals. Through inadvertence, however, reproduction of other documents such as patent specifications and drawings were unnecessarily reduced to a scale too small to be easily read. To remedy this, at the suggestion of opposing counsel, we present with this brief a volume of specifications and drawings of patent exhibits.

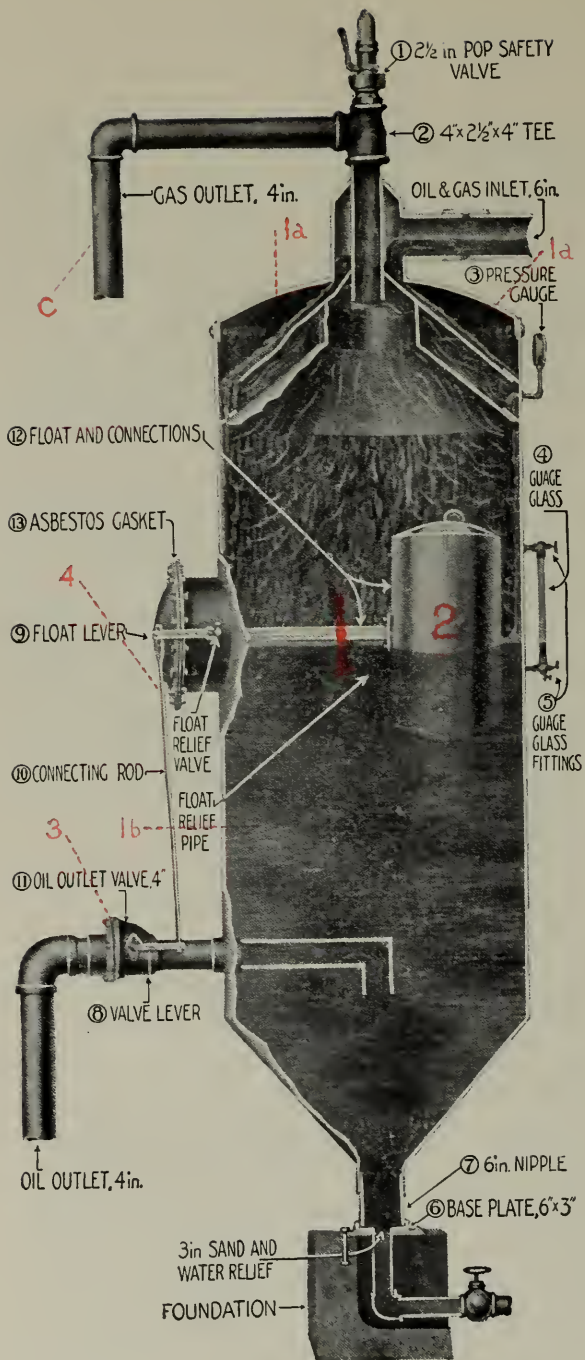
### Statement of the Case.

Infringement is charged of claims 17, 18 and 19 of re-issued Letters Patent No. 15,220 (Book of Exhibits, p. 124; Bound Copies of Patents, p. 1) granted November 8, 1921, to David G. Lorraine for Oil, Gas, and Sand Separator,—which claims have been found by the Trial Court in its opinion (T. R. 1116) valid but not infringed. We do not believe that such finding of validity will be seriously questioned on this appeal—although there were numerous defenses attacking validity suggested on the trial.

It frequently happens that patent claims are impossible of understanding without recourse to accompanying descriptions and drawings, but this is not true in the present instance: the language of the claims is so clear and its application to defendants' device so obvious that additional description would seem superfluous. Dispensing with explanation, therefore, we copy on the following page defendants' illustration (taken from one of defendants' advertisements) of the form of separator here charged to infringe, and on the next succeeding page for easy comparison the claims in suit in analytical form, reference numbers in red on the illustration indicating corresponding numbered elements in the claims. From this it will be apparent at a glance that each and every element of the claims is found in defendants' separator:







CLAIM 17.

An oil and gas separator for oil wells including

- (1) a receptacle having a
  - (a) a receiving chamber therein for the reception of oil and its constituents, and
  - (b) a settling chamber communicating with said receiving chamber;
- (2) a float mounted in the upper portion of said receptacle for regulating the discharge of the oil therefrom, whereby a substantially uniform volume and level of oil may be maintained in said settling chamber at a point above the vertical center of the receptacle.

CLAIM 18.

An oil and gas separator for oil wells, including

- (1) a receptacle having a
  - (a) receiving chamber therein for the reception of oil and its constituents, and
  - (b) a settling chamber communicating with said receiving chamber, said receiving chamber and said settling chamber having
  - (c) a common outlet whereby the gas liberated from the oil in both chambers may be commonly discharged;
- (2) a float mounted in the upper portion of said receptacle for regulating the discharge of the oil therefrom, whereby a substantially uniform volume and level of oil may be maintained in said settling chamber at a point above the vertical center of said receptacle.

CLAIM 19.

An oil and gas separator for oil wells, including

- (1) a receptacle having
  - (a) a receiving chamber and
  - (b) a settling chamber in communication;
- (2) a float in the upper portion of said receptacle, pivotally supported on the walls thereof;
- (3) an oil discharge valve communicating with said settling chamber and externally mounted on said receptacle;
- (4) and means for operatively connecting said float with said valve.

Defendant-Appellees, Townsend, et al., are the holders of Letters Patent No. 1,269,134 (Book of Exhibits, p. 31; Bound copies of Patents, p. 9), granted June 11, 1918, to Milon J. Trumble for Crude Petroleum and Natural Gas Separator, which patent was by Your Honors in the appeal of Lorraine v. Townsend, et al., C. C. A., No. 3945 reported 290 Federal Reporter 54, held valid and found to be infringed by one of several forms of separators theretofore made by the present Plaintiff-Appellant, Lorraine. One of the principal contentions in the last mentioned appeal was that Lorraine also infringed the Trumble patent by making and selling the separator of the present re-issued Letters Patent No. 15,220 in suit; but this court held (290 Federal Reporter, two-thirds down page 59) that properly construed the Trumble claims "did not reach the structure exhibited in the drawings of Appellant's [Lorraine's] patent [Re-issue No. 15,220]."

Lorraine was and is at present in the business on a large scale of making and selling separators made in substantial accordance with the re-issued Letters Patent here in suit, which devices have been highly successful commercially; *and the present suit would never have been instituted if Defendant-Appellees had confined themselves to the manufacture and sale of the device illustrated and described in their Trumbull patent.* Instead, however, they have assiduously copied the combination of the re-issued claims in suit, necessarily altering the construction of the Trumble separator to incorporate the Lorraine invention.

It may be of passing interest to note that this cause was first tried before Judge Trippet (T. R. 62, 72)

and at the conclusion of the trial the court rendered a tentative opinion. Thereafter, the testimony having been transcribed, both sides filed exhaustive briefs. On behalf of Plaintiff and before the trial which resulted in the decision here appealed from, it was repeatedly offered (T. R. 62, 72) to submit the cause on such record, briefs and tentative opinion to Judge Trippet's successor; but counsel for defendants declined this saving of time and expense and insisted upon a new trial, and Judge James, from whose decision this appeal is being prosecuted, being thus denied the aid of Judge Trippet's experience and consideration of the matters involved, decided the case on a new oral argument.

In its opinion near the bottom of T. R. 1114, the Trial Court has found that the addition or incorporation of a certain one of the elements of our claims, namely, the receiving chamber, "marks but a small advance over devices well known and in prior use."

It is dangerous to lightly assume that any advance, however small, is inconsequential when it is claimed as an important feature of a concededly commercially successful device and a competitor appropriates it. Preliminary to our argument we may suggest that if the advance is in fact of little value then it will do no harm to a defendant to be compelled to cease using it, and if the court happens to be mistaken as to its importance, and it is, as we contend, really largely the foundation of the commercially successful separator, with stronger reason it should be protected; for that is why we secured a patent. It is no more right to steal ten cents than to steal a thousand dollars.

On the last page of the Trial Court's opinion (T. R. 1116) validity of the patent in suit is conceded—only within narrow limits it is true (notwithstanding our most earnest contentions to the contrary), *but may we not be protected within those narrow limits at least?*

Most briefly, the court will find the situation to be this: *Defendants make and sell a device which is exactly described by the language of each of the claims in suit; every element of each of these claims literally as described therein is found in defendants' device and each of said corresponding elements performs the same function in the same way and leads to the same result as does the corresponding element and combination of the claims in suit.* There is no attempt in the Trial Court's opinion to meet or explain away this fact. The gist of the decision appears to be that inasmuch as the court finds (erroneously as we contend) the contribution of the patent suit "marks but a small advance" over the prior art, its claim (T. R. 1114 near the bottom of the page) should be dismissed as without merit. Such finding is glaringly inconsistent with the action of this court when, after having found the Trumble patent to be hair-splittingly narrow, Your Honors sustained it and found it infringed.

### The Issues.

After the experience of two trials of this cause, including the preparation of most exhaustive briefs on the first trial, we have in the foregoing statement dwelt almost exclusively upon facts and circumstances

relating to the charge of infringement. We have done this to conserve the time and attention of the court with the idea that if the most emphasized defenses should be found weak and insufficient the value of those which have been neglected by scant attention of most able counsel for defendant-appellees will not be over-appraised, and the court will enter upon their study with no more faith than did counsel apparently conclude.

In the brief before the first Trial Court over one-half of defendant's argument was devoted to the matter of infringement; nearly one-fourth to the defense of alleged new matter in the reissue; about one-twelfth to the defense of non-invention, while the remaining one-sixth was about equally divided among six other defenses, some of which we do not believe will even be mentioned on this appeal.

We shall surely be considered fair, however, if we permit defendant-appellees' counsel to state the issues for us. In his opening statement before the trial court (R. 87) counsel said:

“The first defense here is that the patent is void because the reissue is not for the same invention as the original; the second one is because of the intervening rights of the defendant who is manufacturing what is asserted to be claimed during the time that intervened between the grant of the original patent and the application for the reissue; the third is total anticipation by the traps in common use and made and sold by the Trumble Gas Trap Company prior to Lorraine's invention and more than two years prior to his application for

patent in suit. I say prior to his invention because Your Honor remembers that if it is one day prior to his invention it does not have to be two years prior to his application for the original patent. And the fourth defense is that, properly construed, these claims are limited to a feature which is not present in the defendant's devices."

A glance through the voluminous record will be sufficient present support for our statement that the defense of alleged anticipation by prior use was the principal defense attempted to be established during the trial. It utterly failed, however, for the reason, among other things, that on rebuttal plaintiff produced as witnesses the very men who admittedly had charge of the alleged anticipating traps and who testified to facts conclusively showing the non-existence of said use.

Generally there is found in every patent cause a number of patent specifications and drawings said to illustrate the development of the art, which are either urged as anticipations or in support of a defense of non-invention over the art. While in the case at bar there are a number of patents in evidence, they have not been relied upon as anticipations; and the court will particularly notice from the foregoing quoted opening statement of the issues by Mr. Lyon that there is no defense of non-invention. On the contrary, the subject matter is therein repeatedly referred to by Mr. Lyon as an "invention" and as "Lorraine's invention." No doubt the making of this admission was largely influenced by the fact that Your Honors, after a most



thorough study of the art, had previously found the Trumble patent valid and infringed (290 Fed. 54), and counsel's own argument on such appeal would have been found grossly inconsistent with any suggestion that the commercially successful separator of the Lorraine patent in suit—the device to which defendants have paid the great tribute of imitation (even enduring the inconvenience and expense of this suit rather than forego its advantages)—does not with stronger reason represent an investment of inventive genius.

The fact that defendant-appellees build their hopes on the defense of non-infringement is, therefore, no more a sign that the defense is strong than the actions of an exhausted swimmer are indications that a straw would make a good life preserver.

## ARGUMENT.

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One of the Chief Dangers to Logical Thinking Is the Confusion Resulting From Endeavoring to Consider too Many Things at Once. We Have Had to Struggle With It Throughout This Litigation. The Discussion of Three or Four Defenses in a Single Paragraph Presents a Fertile Field for Unsupported Assertions and False Assumptions Awkward to Handle in Any Seriatim Reply—in Fact It Renders Efficient Aid to Every Known Fallacy. Accordingly Let Us Consider One Thing at a Time.

We refrain for the present from discussing the great commercial value of the combination of the claims in suit because invention is apparently admitted. Logically, the fact that a defendant appropriates an invention is sufficient evidence of its value: if it is desirable enough to be copied without license, it is valuable enough to be protected by the decree of this court.

With the trial court room littered with blue prints, drawings, and photographs, with the great bulk of the record taken up by evidence for or against the defense of prior use—we might reasonably have selected such defense for first consideration, but as a very few later paragraphs will suffice to show the defense must be practically abandoned.

The technical defenses attacking validity of the re-issue will also be easily disposed of.

Accordingly, let us conserve time by directing attention solely to the last refuge of the unauthorized

borrower of plaintiff's ideas—and not permitting ourselves to be diverted and confused by the camouflage of any other defense, let us single out and apply every known test to this defense, which, while admitting that defendants have plainly copied, deny that they have infringed.

**Defendant-Appellees Infringe Because Each and Every Element as Described in the Claims in Suit Is Present in What Is Admittedly Defendants' Device; That Is to Say, Because the Claims Accurately Read on or Describe Defendants' Separator; and Because Considering the Claimed Combination as an Entity or Considering Each Element Separately, Defendants' Device as a Whole and Such Claimed Elements Separately, Perform the Same Functions in Substantially the Same Way, and Lead to the Same Results.**

It will instantly be seen that if the foregoing black letter statements is correct there is not much left to argue; for, as the court will remember, the elementary law, as stated, for instance, in *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405, is that—"the claims measure invention," and as set forth in *Walker on Patents* (5th Ed.), p. 423, Sec. 339":

"A patent for a machine or manufacture is infringed by him who, without ownership or license, makes, uses, or sells any specimen of the thing covered by any claims of that patent \* \* \*

but whoever infringes any one claim of a patent infringes the patent, whether or not it contains other claims which it does not infringe.”

Accordingly, let us check carefully; for if we are correct this issue is very briefly disposed of.

It is elementary that the specifications and drawings may be referred to for better understanding the meaning of words of a claim. “A claim is to be construed in the light of the description,” says Walker on Patents (5th Ed.), page 238, Sec. 182, citing many cases. When, therefore, the claims call for the mounting of the float in the upper portion of the receptacle, reference to the drawings of the patent in suit (Fig 4) shows a vertical cylindrical float with its bottom extending from below the vertical center of the receptacle to a point above its vertical center. This, clearly, is within the range intended by the patentee when he indicates mounting in the upper portion of the receptacle; and it is exactly the location of the float of defendants’ device as shown in their advertisement, *supra*.

The purpose of this mountings is plainly stated in the claims to be to provide a means whereby a substantial volume and level of oil may be maintained. In defendants’ device we see the relatively high float level and we see the consequent high oil level. Now compare the float and oil level of Trumble patent 1,269,134, (Book of Exhibits, p. 31; Bound Copies of Patents, p. 9). Why did not defendants continue to make their separators as illustrated in their patent? Why did they copy?

In comparing the device of the drawings of the Lorraine patent with that of the advertisement of the defendants, *supra*, the court, undoubtedly, has found that element for element, and function for function, the two devices correspond, and that the only difference is that the receiving chamber of Lorraine is segmental (as shown most clearly, perhaps, in Figs. 4 and 5 of the drawings of the Lorraine patent in suit), while the receiving chamber of defendants' device is the space above the cone.

Now one of the principal functions of the Lorraine receiving chamber is that it protects the float from the agitation which would result if the oil were discharged directly into the settling chamber. It is obvious even to an unskilled mechanic that various forms of this receiving chamber might be devised once the purpose and function is understood. For instance, the partition need not be vertical; it might be at an angle. Combined with the provisions for the high oil level, it minimizes agitation and gives a longer period for sand to separate out, thus reducing wear on the valves caused by the cutting action of the not completely separated sand. As a matter of common sense, what difference does form and location make as long as these vital functions are accomplished. Remember always that we charge defendants with infringement because they use the combination of our claims as a *combination*. It is thus totally immaterial that Trumble shows a like receiving chamber when plainly it does not contain the remaining features constituting the combination of the claims in suit.

As we shall immediately show, the circumstance of the Trumble partition between the receiving and settling chambers, namely, the cone, or as it has been called, the baffle plate, also performs an added function, namely, that of spreading out the oil in a thin film (as found by this court, 290 Fed. 54), as well as the fact that the receiving chamber is of a different form and location from the receiving chamber of the patent in suit, is, under the law, immaterial. These circumstances, under well settled law, do not avert a charge of infringement. *On the contrary, the fact that many of the claims of the patent in suit are limited to the form and location of the receiving chamber, while those in suit are not, shows clearly that the Patent Office contemplated a scope of the claims in controversy unlimited by form and location of such receiving chamber.*

**It Is Elementary Law That a Change in Form and Location of One of the Elements of a Combination Does Not Avoid a Charge of Infringement.**

The vital function is indicated by the name of the element "receiving" chamber, because it receives the oil. Other functions are that the partition protects the float and allows a certain amount of quiescence to permit settling of the sand. If these functions are performed by the Trumble partition, then there is equivalency notwithstanding differences of appearance, form, or location. Indeed the courts have frequently and explicitly so held:

In *Adam v. Folger*, 120 Fed. 260, a decision by the Circuit Court of Appeals for the 7th Circuit, Judges Jenkins, Grosscup and Baker, Circuit Judges, decision written by Judge Baker, a judge of long experience in patent law, it was held (2nd paragraph of syllabus):

“While a patent for a combination is not infringed if any one of the elements of the combination is omitted, a change in the form or the location or sequence of the elements will not avoid infringement where they are all employed to perform the same functions, unless form, location or sequence is essential to the result or to the novelty of the claim.”

The case of *Metallic Extraction Co. v. Brown*, 104 Fed. 345, Circuit Court of Appeals for the 8th Circuit, is of extreme pertinence for the reason that it relates, like the case at bar, to the location of a chamber. It should be noted particularly that the location of the chamber in this *Metallic Extraction Company* case *was expressly described in the claim* as “at the side of the main roasting chamber,” yet the court, in view of the functions of the chamber, held that its location, *disclosed in the drawing and as specified in the claim*, was not essential, but that it was infringed by a chamber placed above or beneath the roasting chamber. Near the bottom of page 353, the court said:

“We are unable to find in *Brown’s* specification, considered as an entirety, or in the state of the art at the time his application was filed, sufficient reasons to warrant us in holding that he intended to claim less than what now appears to have been his full invention, and that the language of his claim

locating the supplemental chamber 'at the side of the main roasting chamber' was used deliberately for the purpose of limiting it. We can conceive of no reason for such a self-imposed limitation, since it is obvious that whether the supplemental chamber was placed at the side of the main roasting oven, or underneath, it would operate in the same manner and produce the same result. As we have before intimated, we think that the words stating the location of the supplemental chamber crept into the claim inadvertently, because of the style of furnace that happened to be chosen to illustrate or embody the invention. We are accordingly of opinion that the first claim of the Brown patent should be construed to cover a supplemental chamber placed beneath the main roasting chamber, as in the Ropp device, because a supplemental chamber so placed is a mere mechanical equivalent for one located at the side thereof."

Even, therefore, if our claims *had* specified the receiving chamber as "segmental," the court would not be precluded from making such an application of the doctrine of equivalents which would find a different form and location of chamber to be an infringement.

In *Consolidated Safety Valve Company v. Crosby Steam Gauge & Valve Co.*, 113 U. S. 157, looking to the *purpose and function, effect, and general result* of the combination, the Supreme Court held that a change by a defendant in location and relative position of a chamber, being one of the elements of the claims, did not avoid infringement.

In the case of *Hoyt v. Horne*, 145 U. S. 302, the question of equivalency between a horizontal and a



vertical partition was before the court. This vertical partition in the device there under consideration was called a "mid-feather." The court said:

"The mid-feather is made vertical instead of horizontal, so that the pulp after it leaves the dam circulates in a horizontal instead of a vertical plane; but as it returns to the beater-roll it passes back under the dam, spreading out to the entire width of the tub, and is taken up by the beater-roll precisely as in the Hoyt patent. It is insisted by the defendant in this connection that there is no infringement of the first claim of the Hoyt patent, since the pulp is not circulated 'in vertical planes,' nor is it delivered by the beater-roll 'into the upper section of the vat,' as specified in that claim. Literally it is not. A technical reading of the specification undoubtedly required that the mid-feather should run horizontally instead of vertically; but the object of this was that the pulp should be received and delivered by the beater-roll along its entire length, viz., across the entire width of the tub—and this is accomplished in the same way in both devices. In both engines the beater-roll revolves toward the top of the dam or back-fall, and a similar acceleration of speed is obtained. How the pulp shall circulate at the other end of the tub is a matter of small consequence so long as it shall circulate in vertical planes at the point where it comes in contact with the roll."

The Fact That the Receiving Chamber of Defendants' Device, or Its Partition, Performs an Additional Function Not Performed by the Vertical Partition of the Patent in Suit Does Not Avoid Infringement.

It has been suggested that the Trumble partition performs in addition another function, not wholly performed by the vertical partition of the patent in suit, namely, that of spreading out all the oil in a thin film to assist in separation. Does this alter the fact of equivalency? In the case last quoted from (Hoyt, *et al.* v. Horne, *supra*), continuing the quotation above set forth, the court said:

“An additional function is claimed for the Horne device in the fact that the pulp falling as it descends the dam from a vertical to a horizontal plane in a kind of torsional current, is more thoroughly mixed than in the Hoyt device, where the pulp continues to flow in parallel lines from the time it is delivered by the beater-roll to the time it is received by it again. This may be true, and defendant's engine may be in this particular an improvement upon the other, but he has none the less succeeded in appropriating all that was of value in the Hoyt device.”

Walker on Patents (5th Ed.), Sec. 352, discussing the same point, says:

“If it [the equivalent] performs the same function, the fact that it also performs another function is immaterial to any question of infringement.” (Citing many cases.)

To Construe the Claims in Suit as Though They Contained the Word "Segmental" Before the Words "Receiving Chamber," That Is to Say, to Limit the Claims to the Form and Location of the Receiving Chamber Would Disregard the Clear Intent of the Patent Contract—Would Obliterate Differences Between the Narrow Claims and Those in Suit.

The Omission of Any Limitation in the Claims Sued on as to Form and Location of the Receiving Chamber Can Only Indicate, in View of the Express Limitations of Other Claims Not in Suit, That the Parties to the Patent Contract Intended No Such Limitation to Be Made.

No doubt the court has well in mind the elementary law as decided (first paragraph of syllabus) in *National Hollow Brake Beam Company v. Interchangeable Brake Beam Company*, 106 Fed. 693: "A patent is a contract, and its construction is governed by the same canons of interpretation that control the construction of other grants and agreements." At page 701 of the case last cited, it was said: "When the intention of the parties is manifest, it should control, regardless of inapt expressions and technical rules."

Now, what was the intention of the Government in making this grant as to whether the patentee should be limited to a "segmental" receiving chamber? It is elementary, of course, that every part of an instrument should be looked to to determine its meaning. Hop-

kins on Patents, page 194, puts the law in the form of rule as follows:

“Rule XI. The whole instrument is to be construed together, for the purpose of ascertaining the meaning of the whole and of every part.”

(Citing *Holly v. Vergennes Machine Co.*, 4 Fed. Rep. 74-77.)

Referring now, for instance, to claim 7 (not charged to be infringed), we find the vertical partition dividing the receptacle into “a receiving chamber and a relatively larger settling chamber,” with their means of communication with each other specifically claimed. *This claim clearly limits to the form and location of the chamber.* It was here plainly the intention of the Patent Office to grant *a narrow and specific claim.* The same is true of a number of other claims. When, however, we come to the claims in suit, namely, 17, 18, and 19, we find them *unlimited as to form or position of the receiving chamber.* Why would the Patent Office grant broad claims unless such claims were intended to be construed according to their plain import? If the Patent Office had *not* intended to grant to Lorraine claims which would cover not merely a segmental chamber in combination with the other elements, but *any kind of a receiving chamber*, why were such limitations of the claims in suit omitted? *Clearly these broad claims were granted because the Patent Office recognized that when once the idea of using a separate receiving chamber in combination with a settling chamber was understood, any mechanic by a*

*slight change of location or form could easily evade the narrow claims.* The purpose—and the only sane purpose that can be imagined—underlying the grant of broad claims not limited to the form or location of the receiving chamber was to protect broadly what the Patent Office decided was the invention.

Again let the court examine claim 16, for instance. Under counsel's contention that the broad claims in suit should be limited by interpolating "vertical" and "segmental" those broad claims would be exactly co-extensive with claim 16. If the Patent Office had intended any such effect, why did not the Examiner disallow claims 17, 18, and 19?

Quoting Thomas J. in *Thompson Houston Electric Company v. Nassau Elec. R. Co.*, 110 Fed. 647, Hopkins on Patents, page 198, says:

"The effort should be, in the construction of the letters, to ascribe a purpose to each claim, and to avoid a construction that would deprive a claim of a distinct purpose."

Surely, the rule that in construing a patent claim no word should be disregarded is merely a rule of common sense; for why would the Patent Office require words to be inserted in a claim unless they were to be given effect? Conversely, if the Patent Office after inserting a limitation in one claim omits it in another, can it be for a moment doubted that the omission of the limitation in the broad claim was intended to have some effect?

In concluding this branch of the argument we remind the court that a patentee is required in Sec.

4888, R. S. U. S., to describe “not *all* the modes or forms in which his invention is capable of being expressed, but only what in his opinion is the ‘best mode of applying the same.’ ” When, therefore, the patentee shows in his drawings a vertical segmental chamber, this is to be understood only as the patentee’s idea of one mode of arranging the chamber. This clearly implies that there may be other forms and locations of the receiving chamber which are within the spirit of the invention. Patentee is clearly entitled to all equivalent forms, namely, to those forms which perform the same functions whether they also perform additional functions or not, and even though such additional functions are of the greatest value to the art and are patentable improvements.

**There Can Be No Possible Doubt That the Place Above the Cone of Defendants’ Separator Is Properly Referred to as a “Chamber” for It Is So Designated in Defendants Patent.**

The fact that defendant Trumble in his patent 1,269,134 (Bound Copies of Patents, p. 9), refers to the separator as consisting of two chambers, i. e., an expansion chamber and a settling chamber, furnishes to our mind conclusive proof of the strict technical accuracy of the description of the Lorraine receiving chamber. Notice particularly claim 5 of the Trumble patent which calls for—

“The combination of an oil and gas separator of an expansion chamber having a settling chamber communicating therewith, means for delivering oil and gas into the upper portion of the expansion chamber \* \* \*.”

The Reissue Is for the Same Invention as the Original Letters Patent. The Alleged "New Matter" Consists Merely of a Restatement of Uses and Functions and Explanations of Mode of Operation. There Are No Structural Differences Between the Device Shown and Described in the Original Application and That of the Reissue. Drawings of the Original, Copied Without Change in the Application for Reissue, Show Fully the Combination of the Claims in Suit.

It is not the law that new descriptive or explanatory matter may not be contained in a reissue application. A careful reading of Section 4916 R. S. U. S. will demonstrate this, even without reference to authorities interpreting the statute, which are even more clear. Briefly, the statute provides that a new patent may be issued with a "corrected specification." Manifestly, it would seem that if the specification is to be corrected it must be changed. The statute also provides that the "specifications and claims in every case shall be subject to revision and restriction in the same manner as the original applications are."

Specifically concerning new matter, the statute provides (Sec. 4916, R. S. U. S.):

"\* \* \* no new matter shall be introduced into the specification nor in the case of a machine patent shall the model or drawings be amended, except each by the other."

(Remember there is no change whatever in the drawings of the reissue over those of the original patent.)

Walker on Patents (5th Ed.), Sec. 240, page 301, says:

“The provision, first enacted in 1870, that ‘no new matter shall be introduced into the specification’ is merely another way of saying that a re-issued patent shall be for the same invention as the original. (Powder Co. v. Powder Works, 98 U. S. 138, 1878.) That provision, therefore, neither enlarged nor restricted the reissuability of Letters Patent; and, accordingly, it is not new matter, within its meaning, to state a new use of the invention shown in the original (Broadnax v. Transit Co., 5 Bann. & Ard., 611, 1880), nor to explain, in a reissue, the operation of a device which in the original was only described (Putnam v. Yerington, 2 Ban. & Ard. 243; Potter v. Steward, 18 Blatch, 561, 1881), nor to vary the description of anything described in the original.” (Citing O’Reilly v. Morse, 15 Howard 62, 1853.)

In *American Automotoneer Co. v. Porter*, 232 Fed. 456, Judge Denison, who was a patent lawyer prior to his elevation to the Federal Bench, in his decision said at page 460:

“The further and last statutory condition is that the reissue must be for ‘the same invention.’ It is true that, for purposes of determining infringement, the identity of the patented invention is fixed by the claims; but to apply the same test to identity of invention as between original and reissue loses sight of the difference between the real invention and the originally patented invention, and unless there is such a difference, there is no occasion for reissue. To recognize that difference



and permit it to be corrected is the whole purpose of the reissue statute; and so it seems quite destructive of the statute to assume that the identity of the actual invention is permanently declared and fixed by the form which the original claims are inadvertently allowed to take. In the same way as with reference to mistake, the question of identity is submitted to the Patent Office, and for the same reason its conclusion is to be taken as *prima facie right*. The last sentence of Section 53 even permits the Patent Office, in certain cases, to go entirely outside the record to determine what the original invention was. It follows that only when it is clear that the reissue is not for the same invention are the courts justified in reaching that conclusion; and we take this to be the rule of the decisions hereinafter cited.”

In *Krauth v. Autographic Register Co.*, 285 Fed. 203, it was said:

“In the reissue of the Krauth patent seven new claims were added, and these were based upon the disclosures made in the reissue specification. As to these new claims the original patent was inoperative, and these claims, or at least some of them, the defendant alleges, were based upon the ‘new matter’ introduced into the specification. Defendant’s Exhibit 36 is the reissue letters patent, and the defendant has bracketed with pen and ink therein the so-called new matter added to the specification. The provision that ‘no new matter shall be introduced into the specification’ is only another way of saying that the reissued patent shall be for ‘the same invention’ as the original. The same invention refers to whatever invention was described in the original letters patent and

appears therein to have been intended to be secured thereby.

It is not new matter within the meaning of this provision to state a new use of the invention shown in the original; to explain, in a reissue, the operation of a device which in the original was only described; to vary and enlarge the description of anything inadequately described in the original. Walker on Patents (4th Ed.) Sec. 240, and cases there cited. An examination of the so-called new matter, bracketed as above stated, will disclose that it is not new matter within the meaning of the statute. Section 4916, U. S. R. S. (Comp. St. Sec. 9461). The 'new matter' is the statement of a new use, an explanation of the operation of the device or the varying of the description in the original patent."

In *Potter v. Stewart*, 7 Fed. 215, at page 216, it was held:

"It is of no consequence that the reissue states that certain combinations are found in the machine which will act in a certain way and effect certain results, when the original did not state that such combinations were found there, or failed to state that said modes of operation and said results would follow provided the said combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the said modes of operation and the said results in fact followed in a machine so made. To supply such defects is the very object and office of a reissue."

In the case of *Giant Powder Co. v. California Powder Works*, 98 U. S. 126, also came before the Su-

preme Court, appealed from the California District Court, and the Court, referring to the inhibition of the statute that “no new matter shall be introduced into the specification,” said:

“This prohibition is general, relating to all patents; and by ‘new matter’ we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent.”

The court went on to say further that:

“The legislature was willing to concede to the patentee the right to amend his specification so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake; but was not willing to give him the right to patch up his patent by the *addition of other inventions*, which, though they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived. For such inventions he is required to make a new application, subject to such rights as the public and other inventors may have acquired in the mean time.

This, we think, is what the present statute means, and what, indeed, was the law before its enactment under the previous act of 1836. If decisions can be found which present it in any different aspect, we cannot admit them to be correct expositions of the law.” (Italics ours.)

Of course, applicant for a reissue has the right to new and broadened claims. A comparatively recent

decision by Your Honors in *Woolwine Metal Products Co. v. Boyle*, 279 Fed. 609, is highly pertinent on this as well as other issues involved in the case at bar. In the *Woolwine* case as in the present controversy, the drawings of the original and reissue applications were identical. Five new and additional claims not found in the original were added to the reissue application, and were allowed by the Patent Office. Judge Bledsoe found these claims valid, and Your Honors affirmed.

There is clearly no new invention attempted to be covered by the reissue claims in suit, because the combination of elements mentioned is plainly disclosed in the original drawings. The specification does not describe any new structure.

Of course the presumption is heavily in favor of the validity of the reissue.

As has been seen from the quotation of Walker on Patents, *supra*, the provision regarding new matter, i. e., new inventions, has been part of the law since 1870. To the officers of the Patent Office entrusted with the duty of passing upon the propriety of the grant of reissue letters patent the law on the subject is well known and thoroughly understood, being in fact quite elementary. This court should be very reluctant to overturn the work of the Patent Office except upon the clearest possible showing. We submit that this defense cannot be sustained.

## There Is No Possible Basis for the Defense of Intervening Rights.

A mere recital of the facts will dispose of this defense almost without reference to the authorities or argument.

The original patent was applied for February 5, 1920, and was granted April 5, 1921. A little over a month afterwards (May 9, 1921—see Defendants' Exhibit B, file wrapper and contents of the Lorraine Reissue Application, Book of Exhibits, p. 81), the petition for reissue had been prepared and the oath signed before a notary (as appears from the file wrapper, Book of Exhibits, p. 84). Receipt of petition as of June 7, 1921, was acknowledged by the Patent Office June 10, 1921 (Book of Exhibits, p. 110), but applicant was not given this date as his official application date for the reason only that the usual drawing did not accompany the reissue application, applicant evidently having assumed that as there was no change in the drawings from the original no new drawings were required. The drawings were copied from the original and filed in the Patent Office July 18, 1921. (See application date noted at head of specification and drawings and Book of Exhibits, p. 112.)

The court will take judicial notice of the fact that it takes about a week to receive a patent from Washington. While the original patent was granted April 5, 1921, it could not have been received before April 11, 1921 (April 10, 1921, falls on a Sunday). *Thus, only twenty-eight days elapsed between the actual re-*

*ceipt of the original patent and the execution of papers to apply for the reissue.*

Lorraine testified (T. R. 130-132) that he went straight to his patent attorney about the matter the same day that he received the patent, and that he discovered the defect in his original patent as soon as it was issued and delivered to him. The reissue application was placed in the hands of his attorney immediately (T. R. 130). Delay was caused by the fact that it was thought desirable to have a complete search made of the state of the art before filing the reissue application, but even at that, only twenty-eight days elapsed between the receipt of the original patent and execution of papers for the reissue. The papers were actually on file in Washington June 7 (one month and twenty-six days after the receipt of the original patent by Lorraine).

Now defendants have heretofore contended that their alleged intervening rights commenced *March, 1921* (before the grant of the original patent, April 5, 1921). Of course, it is manifest that there could be no intervening rights until the grant of the original patent, so that if we take the actual facts as appearing of record that Lorraine immediately placed the matter of applying for a reissue in the hands of his attorney, there was no *period of time whatever for rights to intervene*; if we take the date that Lorraine actually executed papers and made oath, we have less than a month after receipt of his patent (namely, from April 11, 1921, to May 9, 1921); if we take the date of the actual filing in the Patent Office, we have less than a month later (June 7, 1921).

The reissue was undoubtedly a broadened reissue, and there is no case on record where more promptness in taking steps to procure a reissue were exercised.

The simplest and clearest statement of the law relating to reissues that we have been able to find is that written by Eugene D. Sewell, Examiner of the United States Patent Office, in a patent text book written by him. Mr. Sewell says:

“The phrase ‘intervening rights’ is frequently used as if any one who, after the grant of a patent, made, used, or sold an invention disclosed therein but not protected by the claims thereof, invested capital for manufacturing it, or obtained a patent covering it, acquired thereby a vested right in that invention, so disclosed but not protected, which would bar the patentee from obtaining a reissue so amended as to cover it. Where there is a clear right to reissue, exercise promptly—as within two years from the date of the patent—there is no such vested right, unless the patentee by his word or deed has given reason for the belief that he intended to relinquish all that he did not claim. As the reissue law provides for the amendment of a patent, the presumption raised by the failure to claim is rebutted by the filing of a reissue application, and any one who invests capital on the presumption of the relinquishment of the matter not covered by the original patent does so at his peril. \* \* \*

Where there is a clear right to reissue, the appropriator of the invention is in somewhat the same position as the finder of a stray horse who appropriates, uses, stables, and feeds him. The original owner who lost the horse has a right to

him that is superior to that of the finder who expended money on his care. So the original patentee has a right to the invention sought in the reissue that is superior to the right of him who intervenes, notwithstanding that money may have been expended by the latter.”

We place great emphasis upon the fact that defendants commence to manufacture the subject matter of our reissue claims before the grant of the original patent. This shows conclusively that they did not adopt the subject matter of the claims in suit *relying upon any apparent dedication to the public by reason of Lorraine's failure to claim*. At the time defendants alleged they adopted the construction, they did not even know that Lorraine had a patent application pending on the subject matter. Suppose that the original patent had contained the claims in suit. Certainly their prior use before the grant of the patent would not have been a defense.

The most conclusive answer, however, to any argument on behalf of defendants on this alleged defense of intervening rights is that the time was too short under the law to give rise to any such rights.

Walker on Patents (5th Ed.), page 295, Sec. 237 (after a full discussion of *Miller v. Brass Co.*, 104 U. S. 354), says:

“The general rule is that a delay for two years or more invalidates a broadened reissue, unless that delay is accounted for and excused by special circumstances.” (Citing many cases.)



Woolwine Metal Products v. Boyle, 279 Fed. 609 (decided by Your Honors) is a complete answer to any argument on the subject of intervening rights in the case at bar. The following outline of dates will be all that is necessary to enable the court to apply the law to the instant case:

Boyle had been manufacturing canteens since 1899. On July 15, 1916, he applied for a patent on the canteen; on June 19, 1917, original patent was granted to Boyle. This original patent contained one claim. On July 18, 1917, defendant Woolwine Products Co., put on the market a similar canteen. On July 26, 1917, defendant assignor applied for a patent on defendant's canteen, and on October 15, 1918, defendant's patent was granted. On November 19, 1917, Boyle commenced suit in this court (Judge Bledsoe); on March 4, 1919, Judge Bledsoe entered a decree finding noninfringement of the Boyle original patent; on April 11, 1919 (a little over a month after the decree of Judge Bledsoe) Boyle applied for a reissue. This reissue added five new claims. (Now, here note that the original having been granted June 19, 1917, and the reissue not having been applied for until April 11, 1919, one year and nine months and four days intervened between the grant of the original patent and the application for the reissue, which was also one year and eight months after defendant, Woolwine Products Company, had commenced making the canteens afterwards found to infringe the five new claims of the reissue patent. On April 5, 1919, Boyle started suit on the reissue patent against the Woolwine Products Company and on September 16, 1921, the

District Court (Judge Bledsoe) entered a decree sustaining the validity of *all new claims of the reissue patent*. This decree was affirmed by this Circuit Court of Appeals in the decision referred to (279 Fed. 609).

If no rights intervened during the nearly two years after defendants started to manufacture and before the grant of the reissue in the Boyle case, how could the almost immediate application of Lorraine be held to have let in any intervening rights, especially when it is not pretended that defendants relied upon any apparent dedication of Lorraine to the public, but actually started manufacture before the grant of the original patent.

Remember there has been no proof whatever offered as to any amount of capital invested in the infringing business prior to the application for our reissue, and after the alleged adoption of the infringing device. Defendants were in the business of making separators—the old unsatisfactory kind. We may assume that they had some capital invested in the manufacture of separators which did not infringe. The amount necessary to change over the unsatisfactory separator to the successful one of the patent in suit has not even been attempted to be established by evidence. No doubt it was negligible. At any rate there is no basis for any finding that considerable or in fact any capital was invested to place upon the market the subject matter of our claims in suit before the application for our reissue.

We submit that Your Honors' decision in the Woolwine case, *supra*, should be followed, and that appli-

cation of such decision makes necessary a finding that the defense in the case at bar cannot be sustained.

There is no anticipation by prior use or otherwise. The only alleged prior uses attempted to be proven were of separators said to have been made by defendants; yet it is conclusively shown of record that defendants were advertising their old form of trap minus the subject-matter of the claims in suit up to the time of the grant of the Lorraine patent—over a year after the filing of its application.

The Lorraine original patent was granted April 5, 1921. (The re-issue, as we have seen, was almost immediately thereafter applied for.) In April, 1921 defendants were advertising for sale the old unsatisfactory separator of the Trumble patent. (Plaintiff's Exhibit 24; Book of Exhibits, p. 40.) Thus for seven years after application for the Trumble patent (from 1914 to and including April 1921) defendants, as shown by their own advertisements, were struggling with the old low level Trumble trap. (Note particularly the low gauge glass shown in the advertisement of April, 1921.)

After the grant of the Lorraine original patent (April, 1921) a remarkable change is shown in the subsequent advertisements (Plaintiff's Exhibit 22; Book of Exhibits, p. 36, et seq.) The court will note the vertical float and the high oil level (which makes use of such float possible), also the gauge glass located above the vertical center.

The foregoing circumstances are also of vital importance on any possible question of invention. If the subject matter of the Lorraine claims in suit was so simple, why did it take seven years for defendants to discover it; and why did they wait until Lorraine showed them how to make the successful trap?

At T. R. 23, in defendants' answer six alleged prior public uses are pleaded. Two of these only, namely, the Honolulu Oil Company of Taft, and the Union Oil Company of Brea, were attempted to be proven. *In both these uses, the devices said to contain the Lorraine invention were separators of defendants; that is to say, they were Trumble traps.*

Circumstances often speak louder than the most positive direct evidence; and the fact that defendants were admittedly advertising for sale their old low level form of trap as late as April, 1921, over a year after application for the original Lorraine patent, to our mind conclusively shows that the invention was not contained in the alleged earlier uses of defendants' traps—otherwise they would have been advertising that successful form rather than advertising the unsuccessful form.

Moreover, defendants produced the weakest possible evidence that the subject of the Lorraine claims in suit was actually used, and this evidence is most positively denied on rebuttal *by men who had actual charge of the separators.*

Paul Paine (T. R. 799), a paid expert on behalf of defendant (T. R. 961), was the only witness relied upon to prove the alleged Taft prior uses. On rebuttal

plaintiff called C. C. Farrah (T. R. 950, *et seq.*) and Thomas I. Sharp (T. R. 857), both disinterested witnesses, who positively and directly contradicted defendants' paid expert as to such uses. It was admitted that Mr. E. R. Pratt was in charge of the alleged prior uses at Taft. He was available, but defendants did not call him. What he would have testified to is set forth in his affidavit (made in our application for a continuance to get his evidence) (T. R. 57). He also positively contradicted Mr. Paine. Irrespective of whether his affidavit is in evidence, and regardless of any error of the court in refusing to grant us the continuance to get his evidence, there is no doubt but that the failure to call him as a witness on behalf of defendants was an admission that defendants knew that he would not testify as they desired.

As to the alleged use by the Union Oil Company at Brea, Thomas F. Morgan (T. R. 533), who was paid for services in testifying and gathering data in support of this defense (T. R. 1104), was relied upon by defendants to establish such use. Mr. Morgan is positively contradicted by a man who was actually present and had charge of and operated the alleged prior uses in question, namely, Ira B. Funk (T. R. 969), employed by the Union Oil Company for research work. Mr. Funk is a disinterested witness; and was not paid for his expert services as a witness.

He says his company objected to their employees being employed and paid as expert witnesses (T. R. 1103). He is certainly far more credible than Mr. Morgan, being clearly unbiased.

If the establishment of the defense of prior use only required a preponderance of the evidence, the court could find this defense had absolutely failed because the great preponderance is on the side of non-existence of any such uses. When, however, it is remembered that the law is clearly that a prior use must be established by evidence *beyond a reasonable doubt* (See case decided by this court of *Schumacher v. Buttonlath Mfg. Co.*, 292 Fed. 523, and authorities cited middle of page 531), it will be appreciated how utterly defendants have failed in their attempted proof. We do not expect any serious effort in this court to sustain either of these defenses of prior use.

We should not conclude this discussion, however, without reminding the court of the fact that a blue print or drawing does not constitute a prior use. Defendants were in business of manufacturing separators from 1914. The court may no doubt take judicial notice of the statement of present counsel for defendant-appellees in plaintiff-appellees' brief p. 7, in No. 3945 of this court, *Lorraine v. Townsend*, where present counsel said: "Trumble Gas Traps went into widespread and general use displacing other gas traps, and became, and are today, the standard gas trap in use in the oil fields of the United States and foreign countries. The evidence shows that at the time of trial of this case [March, 1922], five hundred and eighty-three Trumble traps had been sold for use \* \* \*." If there had really been a prior use of the subject matter of the *Lorraine* invention in any of these nearly six hundred traps, *why could not defendant adequately prove a*

*single one?* These separators are not perishable things—they last for years. There must have been dozens of witnesses who had actually seen and operated them. Why did defendants rely solely upon a paid expert in preference to the men who actually used and operated the traps and upon a witness who was hired to gather data? Let the court consider this evidence in connection with the circumstances that defendants were advertising the old form of traps until after the grant of the Lorraine patent. That is, they were advertising them for sale in April, 1921, over a year after the Lorraine application. We submit a more conclusive failure to prove a prior use cannot be imagined.

### **The Patented Art in No Way Limits the Claims in Suit.**

In the answer twenty patents are pleaded, *but not as anticipations*. To be properly pleaded as anticipations the subject-matter should be alleged to be “patented” in some prior patent or described in some printed publication (which may be letters patent) (leaving out of consideration for the moment anticipation by prior use). The pleading of defendant is merely that the claims in suit are “invalid” in view of the patents mentioned in the answer. [Tr. 21.] Those patents were not offered as anticipations, and were not relied upon, and in fact, during the entire final arguments of Mr. Lyon on both trials we believe that not a single one of them was even mentioned.

As stated by the court in *Forsythe v. Garlock, et al.*, 142, Fed. 461, 463 (Court of Appeals 1st Circuit):

“The citation of so many patents by a respondent in an infringement suit sometimes tends, as we have several times said, not so much to weaken the complainant’s position as to strengthen it, by showing that the trade had long and persistently been seeking in vain for what the complainant finally accomplished.”

### Conclusion.

There were a great many defenses discussed during the first trial which were not mentioned during the second.

We had difficulty in separating the defenses for intelligent consideration, so prone they were to change colors like a chameleon. For instance, the defense of prior use would suddenly change into something resembling a defense of prior invention or knowledge by someone not pleaded in the answer. | However, the many scattered arguments on these changes did not seem to be seriously pressed, but were more in the form of suggestions.

In view of the fact that the court found validity in its opinion, and apparently did not consider many of such numerous defenses of sufficient importance to mention or discuss, and there is no cross appeal, we believe we have made a fair opening in fully discussing the four defenses mentioned by counsel in his opening statement quoted *supra*, and we believe we have fully met and answered any suggestions or reasons in sup-



port of the failure to find infringement in the trial court's opinion.

In conclusion we urge that the claims in suit are in no way limited by the art, and their subject-matter has been clearly appropriated without license by defendants.

We respectfully submit that the decree appealed from should be reversed with costs and the trial court directed to enter a decree in favor of plaintiff finding the claims in suit valid and infringed, granting the injunctive relief prayed, and referring the cause to a Master to determine the damages and profits.

Respectfully submitted,

WESTALL AND WALLACE,

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